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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,520	10/16/2003	Shogo Yamamoto	2860.0721-02	5065

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EXAMINER	
VARGOT, MATHIEU D	

ART UNIT	PAPER NUMBER
1732	

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/685,520	YAMAMOTO ET AL.	
	Examiner	Art Unit	
	Mathieu D. Vargot	1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 67-82 is/are pending in the application.

4a) Of the above claim(s) 82 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 67-81 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 10/206,187.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 2/23/2004.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1.Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 67-81, drawn to a mold and method of molding using the mold, classified in class 264, subclass 2.5.

II. Claim 82, drawn to a method of molding an optical component, classified in class 264, subclass 1.1.

The inventions are independent or distinct, each from the other because:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions have different modes of operation, in that the claims of Group I call for various resin flow paths while Group II calls for using plural gates and varying the timing, such not required in Group I.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Hill on February 28, 2006 a provisional election was made with traverse to prosecute the invention of Group I, claims 67-81. Affirmation of this election must be made by applicant in replying to this Office action. Claim 82 has been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the

requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

2.Claims 74-77 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 74-76, the meaning of "becomes almost" is unclear in meaning. Does applicant mean that the cross section changes along the path of the resin flow or does

the cross sectional shape remain the same but is "almost" the recited form? Also, it is unclear what constitutes "almost" a circle, trapezoid and semicircle. The dependency of claim 77 needs to be changed to –76—in that 'the semicircle" lacks antecedent basis from claim 67. Also, how close do the normal line to the chord and optical axis of the optical functional surface have to be so that they "almost agree" with each other? It is submitted that the use of the language "almost" in these claims renders them indefinite in that such a term is open to interpretation.

3.The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 67, 71-73 and 81 are rejected under 35 U.S.C. 102(b) as being anticipated by Shiao et al (see Fig. 4).

The applied reference discloses the instant mold and method of using same to make an optical component—see the first resin flow path from the gate (8), a second resin flow path perpendicular thereto and with a smaller cross sectional area than that of the first flow path and an optical functional section which molds the lens. The flow paths are interconnected in the instant manner to produce a supporting shaft section from the first resin flow path (ie, where the resin is injected), connecting section from the second resin flow path and an optical functional section from the mold. It is submitted that Shiao et al clearly shows that the cross sectional size of the first resin flow path, while not constant, is larger at gate 8 than the cross sectional area of the second resin flow

path, and it certainly is larger at the junction of the two paths and hence claim 67 is anticipated. Claim 67 does not call for any of the resin flow paths to have constant cross sectional areas—indeed, claims 74-76 suggest that at least the first path is not constant—and the cross section of the second flow path is clearly smaller at the junction in Shiao et al.

4.The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 69, 70, 74-76 and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiao et al.

Shiao et al is applied for reasons of record, the reference disclosing the basic claimed mold lacking essentially the aspects of the straight line relationship between the first and second resin flow paths and a showing of the exact cross sectional shape of the first resin flow path. It is submitted that these would have been obvious modifications to the mold of the applied reference dependent on the exact shape of the supporting shaft desired.

5.Claims 68, 78 and 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiao et al in view of Fukuda et al (see 6 in Figs. 4 and 5).

Shiao et al is applied for reasons of record, the primary reference essentially lacking the aspect of the first resin flow path having a portion which forms a distinguishing mark on the supporting shaft section. Fukuda et al shows this in the molding of a lens and such

would have been an obvious feature in the mold of the primary reference to identify the gate and mold which makes the lens.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mathieu D. Vargot whose telephone number is 571 272-1211. The examiner can normally be reached on Mon-Fri from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni, can be reached on 571 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Vargot
March 30, 2006

M. Vargot
Mathieu D. Vargot
Primary Examiner
Art Unit 1732

3/30/06